

REMARKS

Claims 1-45 are pending in the present application. Claims 1, 2, 5, 7-11, 16, 17, 20, 22-26, and 31-37 are amended. Claims 41-45 are added. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 112, Second Paragraph

The Office Action rejects claims 1-40 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to explicitly define the unique characteristics of the disclosure with respect to the current art. This rejection is respectfully traversed.

The Office Action quotes the second paragraph of 35 U.S.C. § 112 as follows:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

However, it is respectfully submitted that the Office Action proffers no analysis as to why the claims fail to define the invention. In fact, the Office Action does not present a rejection under 35 U.S.C. § 102 indicating that the claims recite the invention of another

Applicants submit that, contrary to the Office Action's assertions, as required by 35 U.S.C. § 112, claims 1-40 point out and distinctly claim the subject matter which the applicant regards as the invention. That is, contrary to the Office Action's assertions, there is no requirement under § 112(2) that the claims address the "current art."

For at least the above reasons, Applicants submit that this rejection of claims 1-40 under 35 U.S.C. § 112 is groundless and, thus, should be withdrawn.

II. 35 U.S.C. § 103, Obviousness

The Office Action rejects claims 1-40 under 35 U.S.C. § 103 as being unpatentable over *Geller et al.* (US Patent No. 6,236,990) in view of *Walker et al.* (US Patent No. 6,131,086). This rejection is respectfully traversed.

With respect to all of claims 1-40, the Office Action states:

As per claims 1-40 Geller teaches a method of presenting information on products and ranking these products(Abstract)(Fig 2A)(Fig 2B) and calculating user preferences(Fig 3) through filtering as well as

calculating rankings and scores(col 8 lines 27-48) of products based on consumer interests. Walker teaches permitting users to purchase products(Abstract)(Fig 7)(Fig 8) of all varieties(col 3 lines 18-29) and a variety of vendors(col 5 lines 35-50) as well as allocating purchasing time for the products(Fig 11A)(Fig 11B)(col 7 lines 30-44).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Geller in view of Walker to teach the invention. The motivation to combine is to teach a system for making products immediately available to users as enunciated by Walker(col 2 lines 3-5).

Office Action, dated March 24, 2003. Applicants respectfully disagree. In fact, Applicants submit that *Geller* and *Walker*, alone or in combination, do not disclose the features recited in the claims.

Instead, *Geller* merely teaches a method and system for ranking products according to a user's preferences. The method and system of *Geller* include a catalog of products, which are evaluated by experts who can compare each of the products and how they rate with respect to certain attributes. See col. 2, lines 18-46. Products may then be ranked according to score presented on a display. See FIG. 2B.

Walker merely teaches a method and system for allowing television viewers to purchase products seen on a television program. The method and system of *Walker* includes a call center, which viewers may call to purchase products. The products are associated with a program, including a time within the program in which the product appeared. For example, if a viewer sees a television personality spill coffee on his suit, the viewer may call the call center and purchase the suit featured in the program. The operator references a database to locate the product information associated with the television program. See FIG. 6; col. 5, lines 10-34.

In contradistinction, the present invention, as set forth in claim 1, for example, recites:

1. A method of presenting information via a digital device having presentation resources, comprising:

receiving bids for the presentation resources of the digital device from a plurality of product/service providers, wherein each bid identifies a benefit, associated with a product/service of a given product/service provider, offered to a user of the digital device;
ranking the bids based on the benefit offered to the user;
apportioning the presentation resources of the digital device in accordance with the ranking of the bids; and

presenting information for at least one of the plurality of product/service providers using the apportioned presentation resources. [emphasis added]

It is respectfully submitted that neither *Geller* nor *Walker* teaches or suggests at least “receiving bids for the presentation resources of the digital device from a plurality of product/service providers” and “apportioning the presentation resources of the digital device in accordance with the ranking of the bids,” as recited in claim 1, for example. The applied references, taken alone or in combination, fail to teach or suggest the claimed invention; therefore, at least claim 1 cannot be rendered obvious by a combination of *Geller* and *Walker*.

The Office Action attempts to use the claimed invention as an “instruction manual” or “template” to piece together the teachings of the prior art so that the invention is rendered obvious. However, as set forth in *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992), such reliance is an impermissible use of hindsight with the benefit of Applicant's disclosure. That is, as set forth in *In re Fritch*, absent some teaching, suggestion, or incentive in the prior art, *Geller* and *Walker* cannot be properly combined to form the claimed invention. Such proposed combination can be reached only through an impermissible use of hindsight with the benefit of Applicants' disclosure as a model for the needed changes. Applicants submit that, contrary to the Office Action's assertions, the motivation of “to teach a system for making products immediately available to users,” although loosely paraphrased from the teachings of *Walker*, does not constitute a suggestion to combine with the teachings of *Geller*.

Furthermore, references are not properly combinable or modifiable if their intended function is destroyed. See *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959), where the court held that, “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.”

In the instant case, the intended function of *Geller* is to allow rank products based upon a certain attribute. As such, a user may rank products by score to identify a product that meets user preferences. On the other hand, the intended function of *Walker* is to

make specific products available to television viewers when the product is identified by viewing a television program. There is no specific product identified in *Geller* and there is no need to rank products in *Walker*. At least for these reasons, the references are not combinable.

Independent claims 16 and 32 recite at least the similar subject matter addressed above with respect to claim 1 and are allowable at least for the same reasons. Since claims 5-11, 20-26, 31, and 34-37 depend from claims 1, 16, and 32, at least the same distinctions between *Geller* and *Walker* and the invention recited in claims 1, 16, and 32 apply for these claims. Additionally, claims 5-11, 20-26, 31, and 34-37 recite other additional combinations of features not suggested by the reference. Consequently, it is respectfully urged that the rejection of claims 1, 5-11, 16, 20-26, 31, 32, and 34-37 be withdrawn.

Claims 2, 17, and 33 are amended to be in independent form. For example, claim 2 recites:

2. A method of presenting information via a digital device, comprising:
 - transmitting a request for information from at least one product/service provider;
 - filtering out unwanted information from product/service providers;
 - receiving the information from the at least one product/service provider, the information identifying a benefit, associated with a product/service of the at least one product/service provider, offered to a user of the digital device;
 - ranking the information based on the benefit offered to the user; and
 - presenting the information via the digital device in accordance with the ranking of the information such that higher ranking information is presented more prominently than lower ranking information.

It is respectfully submitted that neither *Geller* nor *Walker* teaches or suggests at least “transmitting a request for information from at least one product/service provider” and “filtering out unwanted information from product/service providers,” as originally presented in claim 2. In fact, these features are not addressed in the Office Action. The Office Action fails to establish a *prima facie* case of obviousness for claim 2. The applied references, taken alone or in combination, fail to teach or suggest each and every

claim limitation. Therefore, it is respectfully submitted that the rejection is improper and should be withdrawn.

Independent claims 17 and 33 recite at least similar allowable subject matter addressed above with respect to claim 2 and are allowable for the same reasons. At least because claims 3, 4, 12-15, 18, 19, 27-30, and 38-40 depend from claims 2, 17, and 33, at least the same distinctions between *Geller* and *Walker* and the invention recited in claims 2, 17, and 33 apply for these claims. Additionally, claims 3, 4, 12-15, 18, 19, 27-30, and 38-40 recite other additional combinations of features not suggested by the reference. Consequently, it is respectfully urged that the rejection of claims 2-4, 12-15, 17-19, 27-30, 33, and 38-40 be withdrawn.

For at least the above reasons, Applicants request that the rejection of claims 1-40 under 35 U.S.C. § 103 be withdrawn.

New claims 41-45 recite at least similar allowable subject matter addressed above with respect to claims 1-40 and are allowable at least for the same reasons. Furthermore, claims 41-43 recite, “wherein higher ranking bids are apportioned more presentation resources than lower ranking bids.” Claim 44 recites, “apportioning an amount of the presentation resources of the digital device in accordance with the ranking of the information such that higher ranking information is apportioned more presentation resources than lower ranking information.” And, claim 45 recites, “wherein the presentation resources include at least one of display space, display duration, and audio duration.” It is submitted that the prior art of record does not teach or suggest at least these features. For at least these reasons, new claims 41-45 are believed to be allowable.

III. Conclusion

It is respectfully urged that the subject application is patentable at least over *Geller* and *Walker* and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE:

July 23, 2003

Respectfully submitted,



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